

**Trilateral Project B3a**  
**Exchange of Search Results**

**Report on Concurrent Search Pilot Program**  
**(Paris-route)**

**San Francisco, California**  
**November 5-9, 2001**

**European Patent Office**  
**Japan Patent Office**  
**United States Patent and Trademark Office**

## **Report on Concurrent Search Pilot Program (Paris-route)**

### **Carried Out under Trilateral Project B3a**

#### **1. Introduction**

- (1) At the 15<sup>th</sup> Trilateral Conference held in Kyoto in November 1997, the Trilateral Offices recognized that the globalization of industry and trade has created the need for a world-wide patent granting system. The Trilateral Offices agreed to undertake further steps through collaboration on concurrent searches concerning applications filed in each of the three Offices and to improve search effectiveness by increased reliance on each other's search results for examination purposes. The Trilateral Offices agreed to undertake a concurrent search program using PCT applications in 18 technical fields (hereinafter referred to as the "'98 Concurrent Search program").
- (2) While the Trilateral Offices underlined that the "'98 Concurrent Search program" has contributed to a better understanding of each other's search methods and search tools through pre-search and post-search discussion among examiners of the three Offices, the three Offices also realized that the schedule of this program was not flexible because of the time limit for preparing the International Search Report (ISR) and that the results of concurrent searches would not be useful to the second and third Office examiners, if the applicant chooses not to enter the national or regional stage in these Offices.
- (3) In this context, at the Sixteenth Trilateral Conference held in Miami in November 1998, the Trilateral Offices agreed to use national/regional applications, instead of PCT applications in a new pilot program. The Trilateral Offices announced the commencement of the pilot program on May 26, 1999. A national/regional application must be first filed in one of the three Offices and subsequently filed in the other two Offices claiming priority rights when participating in this new Concurrent Search pilot program. The new pilot program was available to applications in all fields of technology.
- (4) However, the circumstances were such that the number of requests to participate in this pilot program was extremely smaller than expected and the results did not justify continuing this pilot program. At the Trilateral Technical Meeting held in Tokyo on June of 2000, the Trilateral Offices agreed to terminate this pilot program, and an announcement to terminate the pilot program was made on the Trilateral Web Site and through other forms of public notice on August 31, 2000.
- (5) At the Trilateral Conference held in Awajishima on November of 2000, the Trilateral Offices agreed that the JPO would draft the final report of this pilot program after completion of the remaining cases.

## **2. Purpose of this Pilot Program**

- (a) Greater mutual understanding and further technical cooperation among the Trilateral Offices
- (b) Increased sharing of information among examiners in the Trilateral Offices
- (c) Enhanced knowledge transfer with respect to both working methods and search tools

## **3. Applications eligible for this Pilot Program**

This pilot program would be initiated upon applicant's request. In order to be eligible to participate in this pilot program, the following conditions must be met:

- (a) a national/regional application (PCT applications excluded) must be first filed in the EPO, or the JPO or the USPTO;
- (b) corresponding applications must be filed in the remaining two Trilateral Offices;
- (c) the claims in the first filed application and the corresponding applications must be drawn to the same invention;<sup>1</sup>
- (d) no first Office action on the merits/search report has been issued on the application by any of the Trilateral Offices;
- (e) the applicant must file a request/petition for participation in this pilot program in each of the Trilateral Offices where the national/regional application was filed;<sup>2</sup>
- (f) the said request/petition filed in each Trilateral Office must include the application numbers and filing dates of the corresponding applications (if known) filed in the other Trilateral Offices;<sup>3</sup> and
- (g) for the USPTO, the request/petition must be accompanied by the required petition fee (37 CFR 1.17(i)).

## **4. Procedures**

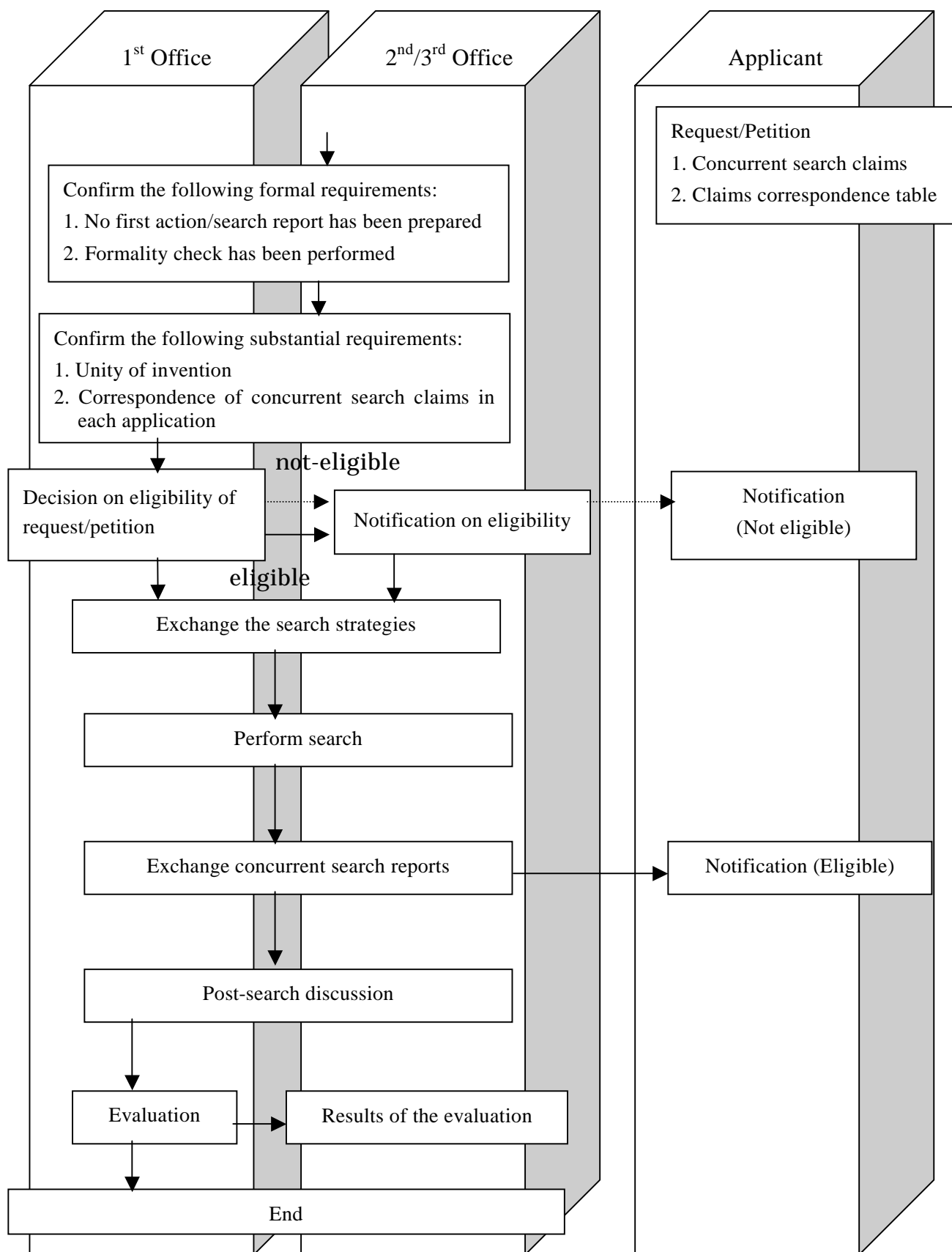
See Figure1 below.

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<sup>1</sup> For this purpose, the applicant is required to submit a set of claims, in the English language, for a concurrent search along with a "claims correspondence table" to each Trilateral Office no later than three months from the filing date of the last corresponding application. The "claims correspondence table" must indicate how each claim in the set of claims for concurrent search corresponds to the claims filed in each of the three applications

<sup>2</sup> For this purpose, the applicant must use each Office's request form. The request/petition will permit an office to take the application out of turn or defer action until the application is ready for concurrent search.

<sup>3</sup> If the application numbers and filing dates of the corresponding applications are not known at the time of filing of a request/petition in a Trilateral Office, applicant must submit such information to the Trilateral Office when the information becomes available.



[Figure 1] Procedures

## **5. Applications Requesting Participation**

The Trilateral Offices received 15 applications with requests to participate in this pilot program. Of the 15 applications, 9 applications were eligible for this pilot program and were completed based on the terms and conditions of this pilot program. The other 6 applications were not eligible for lack of unity of invention etc. (See Appendix A).

## **6. Results of this Pilot Program**

As mentioned above, since no more than 9 applications were completed based on the terms and conditions of the pilot program, and the technical fields to which the inventions of these applications pertain had no common features, it did not seem proper to infer certain generalized conclusions. Consequently, this section only provides the facts obtained through this pilot program.

### **6.1 Assessment of novelty and inventive step requirements**

- (1) Each Office was able to find material art for 8 of the 9 applications to attribute to the claims searched on its own prior to exchange of concurrent search report prepared by each Office.
- (2) Number of cases or claims where the results of assessment made prior to discussion by the three Offices were the same
  - (i) Application-base (9 total cases)

For analytical purposes, where an application has a claim for which at least one “X” or “Y”-assigned reference is cited, the application is assessed to lack “novelty” or not meeting the “inventive step” requirement.

EPO-JPO	JPO-USPTO	USPTO-EPO	three Offices
7 cases	7 cases	9 cases	7 cases

The results of assessment made prior to discussion by the three Offices were the same in 7cases of 9 total cases.

- (ii) Claim-base ( 95 total claims )

For analytical purposes, where at least one “X” or “Y”-assigned reference is cited for a claim, the claim is assessed to lack “novelty” or not meeting the “inventive step” requirement.

EPO-JPO	JPO-USPTO	USPTO-EPO	three Offices
50 claims	50 claims	69 claims	37 claims

The results of assessment made prior to discussion by the three Offices were the same in 37 claims of 95 total claims.

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  - (3) Number of cases or claims where the results of assessment made prior to and after

discussion were the same

The method of assessment of the “novelty” or “inventive step” requirements is the same as in (2). Here, for analytical purposes, category shifting is defined as follows:

- “not shifted” : (“X or Y” to “X or Y”) (“A” to “A”)  
 “up” : (“A or no-category assigned” to “X or Y”)  
 “down” : (“X or Y” to “A or no-category assigned”)

(i) Application-base (9 total cases)

	EPO	JPO	USPTO
not shifted	8 cases	6 cases	8 cases
up	0	1 case	0
down	1 case	2 cases	1 cases
Total number of cases	9 cases	9 cases	9 cases

(ii) Claim-base ( of those to which a category was assigned of the 95 total claims )

	EPO	JPO	USPTO
not shifted	60 claims(69%)	57 claims(61%)	61 claims(69%)
up	17 claims(20%)	17 claims(18%)	16 claims(18%)
down	10 claims(11%)	19 claims(20%)	11 claims(13%)
Total number of claims	87 claims	93 claims	88 claims

The number or proportion of claims whose category assigned prior to discussion shifted to “up” after discussion was almost identical among the three Offices.

## **6.2 Contents of cited references**

(1) Number of cited references (including “A”-assigned references)

(i) Application-base (9 total cases)

	EPO	JPO	USPTO	Total number of References (excluding overlapping references)	References cited after discussion
Number of cited references	42	62	74	168	Number: 69
Average number of cited references per application	4.6	6.9	8.2		Proportion: 41%

(ii) Claim-base ( 95 total claims )

	EPO	JPO	USPTO	Total number of References (excluding overlapping references)	References cited after discussion
Number of cited	238	299	388	847	Number: 374

references					
Average number of cited references per claim	2.5	3.1	4.8		Proportion: 44%

The USPTO cited the greatest number of references both in application-base and claim-base among the three Offices. The proportion of the references cited after discussion among all references cited by each of the three Offices is a little more than 40%.

- (2) Number of identical references commonly cited by the three Offices (including references to which A-categories were assigned)

- (i) Application-base ( 168 references for 9 cases )

	EPO-JPO	JPO-USPTO	USPTO-EPO	Three Offices
Number of identical references	2	2	2	0

- (ii) Claim-base ( 847 references for 95 claims )

	EPO-JPO	JPO-USPTO	USPTO-EPO	Three Offices
Number of identical references	41	10	27	0

There were no corresponding applications or claims in which the three Offices cited an identical reference. The proportions of identical references cited by two Offices for corresponding applications or claims were only several percentages.

### **6.3 Types of cited references**

Application-base ( 168 references cited for 9 cases )

	EP	JP	US	WO	DE	GB	NPL
EPO	31%	5%	36%	17%	5%	2%	5%
JPO	3%	61%	29%	2%	0%	0%	5%
USPTO	27%	1%	60%	1%	0%	0%	11%

Both the JPO and USPTO cited the great proportions of their own national patent literature, whereas the EPO cited a comparatively greater proportion of non-EP patent literature.

### **6.4 Conclusion**

Each Office was able to find material art for 8 of the 9 applications to attribute to the claims searched on its own. Although the number of applications or claims subjected to this program was too small to deduce a general conclusion, the results of section 6.1(3) suggest that much benefit did not result from the collaboration among the examiners in the Trilateral Offices, namely, a comparison of shared search results did not significantly change the examiner's determination on

“novelty” or “inventive step” requirements of the claims.



## Appendix A: List of the Requested Applications

No	Application Number			1 <sup>st</sup> Office	Applicant	Date of Finish & Result
	IPC Classification			Claims		
1	EP**/*****	JP***_*****	US**/*****	JPO	*****	October 25, 1999 Finished
	G11B7/125	G11B7/125	G02B27/10	47		
2	EP**/*****	JP***_*****	US**/*****	JPO	*****	August 16, 1999 Lack of unity of invention in USPTO
	-	-	-	43		
3	EP**/*****	JP***_*****	US**/*****	JPO	*****	March 21 2000 Finished
	H04N9/804	H04N5/781	H04N9/804	9		
4	EP**/*****	JP***_*****	US**/*****	JPO	*****	February 24, 2000 The concurrent claims is not correspondent with JPO application
	-	-	-	15		
5	EP**/*****	JP***_*****	US**/*****	JPO	*****	March 15, 2000 EPO has issued SR.
	-	-	-	7		
6	EP**/*****	JP***_*****	US**/*****	JPO	*****	April 19, 2000 Finished
	G05B19/18	G05B19/18	G05B19/18	7		
7	EP**/*****	JP***_*****	US**/*****	JPO	*****	August 11, 2000 Finished
	G11B5/60	G11B5/187	G11B5/60	10		
8	EP**/*****	JP***_*****	US**/*****	USPTO	*****	December 7, 2000 Finished
	H04N1/00	H04N1/387	G06F17/60	3		
9	EP**/*****	JP***_*****	US**/*****	USPTO	*****	July 26, 2000 Lack of unity of invention in JPO
	-	-	-	3		
10	EP**/*****	JP***_*****	US**/*****	USPTO	*****	December 19, 2000 Finished
	H04N1/00	H04N1/387	G06F17/60	3		
11	EP**/*****	JP***_*****	US**/*****	USPTO	*****	December 19, 2000 Finished
	G06T11/00	H04N1/60	H04N1/64	3		
12	EP**/*****	JP***_*****	US**/*****	USPTO	*****	January 31, 2001 Finished
	G09B5/14	G9B7/02	H04N7/14	3		
13	EP**/*****	JP***_*****	US**/*****	JPO	*****	December 21, 2000 USPTO has sent a Notice of Allowance.
	-	-	-	10		
14	-	-	US**/*****	USPTO	*****	March 20, 2001 Corresponding applications were not submitted to EPO and JPO.
	-	-	-	-		
15	EP**/*****	JP***_*****	US**/*****	USPTO	*****	June 27, 2001 Finished



: Applications that were not eligible